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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,501	03/31/2004	Peter Siepen	10191/3614	6467
26646 7590 02/25/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER SHEER, CRISTINA O				
ART UNIT 3621		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,501

Applicant(s)

SIEPEN ET AL.

Examiner

CRISTINA OWEN SHERR

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to applicant's amendment filed December 3, 2007. Claims 1-18 are currently pending in this case. Claims 1-14 and 17-18 are currently under examination.

Response to Arguments

2. Applicant's arguments with respect to claims 1-14 and 17-18 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-14 and 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Independent claims 1 and 17 make reference to a system or method for "outputting useful data in a vehicle". This phrase is ambiguous as to whether the system or device is inside the vehicle or the data is inside the vehicle.

6. For these reasons, independent claims 1 and 17 and their dependent claims 2-14 and 18 are rejected under 35 U.S.C. 112.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-14 and 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Taniguchi et al (US 7,212,989).

9. Regarding claim 1 -

Taniguchi discloses a method for outputting protected useful data in a vehicle (e.g. abs), the method comprising: granting a usage authorization of the data in the vehicle as a function of one of a road traveled and an area traveled (e.g. col 8 ln 30-47). We note that it is inherent that a vehicle-mounted apparatus may be mounted anywhere on the vehicle, including inside the vehicle, such as the dashboard or outside the vehicle such as on the hood.

10. Regarding claim 2 –

Taniguchi discloses a method as in claim 1, wherein the data is encrypted data (e.g. col 7 ln 55-60).

11. Regarding claim 3 –

Taniguchi discloses a method according to claim 1, further comprising transmitting the useful data via a radio signal into the vehicle (e.g. col 7 ln 62-67).

12. Regarding claim 4 –

Taniguchi discloses a method according to claim 1, further comprising providing the useful data on a storage medium in the vehicle. (e.g. col 2 ln 47-57).

13. Regarding claim 5 –

Taniguchi discloses a method according to claim 1, further comprising transmitting the usage authorization via a radio signal into the vehicle. (e.g. col 7 ln 32-40).

14. Regarding claim 6 –

Taniguchi discloses a method according to claim 1, further comprising providing the usage authorization on a storage medium in the vehicle.(e.g. col 2 ln 47-58).

15. Regarding claim 8 –

Taniguchi discloses a method according to claim 1, further comprising determining using a navigation system whether the vehicle is located inside the area for which a usage authorization was granted. (e.g. col 4 ln 19-34).

16. Regarding claim 8 –

Taniguchi discloses a method according to claim 1, further comprising electronically debiting a fee for the usage authorization as soon as one of (a) the useful data is played back, (b) a specific area is traveled and (c) a specific road is traveled.(e.g. col 4 ln 42-59).

17. Regarding claim 9 –

Taniguchi discloses a method according to claim 1, further comprising checking in a rights analysis unit, which is coupled to a playback unit, whether a usage right exists for the useful data to be played back. (e.g. col 11 ln 1-3).

18. Regarding claim 10 –

Taniguchi discloses a method according to claim 9, further comprising decrypting the useful data in the rights analysis unit. (e.g. col 9 ln 30-47).

19. Regarding claim 11 –

Taniguchi discloses a method according to claim 9, further comprising: transmitting a decoding key from the rights analysis unit to the playback unit; and decrypting the useful data in the playback unit using the decoding key. (e.g. col 9 ln 30-47).

20. Regarding claim 12 –

Taniguchi discloses a method according to claim 9, further comprising granting the usage right with a time restriction. (e.g. col 9 ln 30-47).

21. Regarding claim 13 –

Taniguchi discloses a method according to claim 9, further comprising granting the usage right for a specific road type. (e.g. col 9 ln 30-47).1

22. Regarding claim 14 –

Taniguchi discloses a method according to claim 13, wherein the usage right is granted for toll roads of an operating company (e.g. col 22 ln 57-67).

23. Regarding claim 17-18 –

Claims 17-18 are rejected under the same criteria as above.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 1-4 and 17-18 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi et al (US 7,212,989).¹ It is the Examiner's principle position that the claims are anticipated because of the inherencies noted above in Takeuchi.

26. However, if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to mount , place or locate the system, apparatus or device of Takeuchi inside the vehicle such as on the dashboard or even in the trunk, rather than outside the vehicle such as on the hood. The motivation for this would be a desire to prevent theft of the said device.

27. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

29. Hoshino et al (US 6,088,680) discloses automatic toll adjusting system, and storage medium with a radio communication function, frequency converting apparatus, writing apparatus, settling apparatus, depositing apparatus and inquiring apparatus therefor.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3621

32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cristina Owen Sherr

Patent Examiner, AU 3621

/Bradley B Bayat/

Primary Examiner, Art Unit 3621